

REMARKS

Claims 1-18 are pending in the present application.

In the Office Action mailed June 12, 2006, the Examiner rejected claim 18 under 35 U.S.C. §101. The Examiner rejected 1, 4, 7-12, 14-16 and 18 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,946,621 by Chheda, et al (hereinafter “Chheda”). The examiner rejected claims 2, 3, 5, and 6 under 35 U.S.C. §103(a) as being unpatentable over Chheda in view of U.S. Patent No. 6,535,738 by Bomar et al (hereinafter “Bomar”). The Examiner rejected claims 13 and 17 under 35 U.S.C. §103(a) as being unpatentable over Chheda in view of U.S. Application No. 2004/0147262 A1 by Lescuyer, et al (hereinafter “Lescuyer”).

Applicants respectfully respond to this Office Action.

35 U.S.C. §101

Applicants respectfully traverse the 35 U.S.C. §101 rejection to claim 18. The Examiner is directed to examine MPEP section 2106 and the related citations to *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F. 3d 1368. State Street spells out the very narrow conditions under which material is found to be non-statutory, and claim 18 does not meet these conditions. The claim 18 preamble recites “Processor readable media operable to perform the following steps:”, after which the steps are clearly spelled out. Those of skill in the art will readily understand the meaning of “processor readable media”, as will as those who read MPEP section 2106’s references to embodiments in computer readable media. The steps enumerated in claim 18, embodied in processor readable media, form a claim that is clearly within the proper bounds of 35 U.S.C. §101. Therefore the Examiner’s rejection should be withdrawn.

35 U.S.C. §102

The standard for anticipation under §102 requires “the presence in a single prior art disclosure of all elements of a claimed invention arranged as in that claim.” Carella v. Starlight Archery & Pro Line Co., 804 F.2d 135, 138, 231 U.S.P.Q.D (BNA) 644, 646 (Fed. Cir. 1998) (*quoting Panduit Corp. v. Dennison Mfg. Co.*, 774 F.2d 1082, 1101, 227 U.S.P.Q. (BNA) 337, 350 (Fed. Cir. 1985)) (*additional citations omitted*). As discussed further below, the Examiner has failed to identify each and every claim limitation, and has therefore failed to set forth a *prima facie* case for anticipation as required by §102.

Regarding the claims generally, Chheda teaches the formation of a neighbor set subsequent to a handoff. The neighbor set is selected in various ways. While the neighbor set is ranked (per the Examiner’s citation, Column 3, line 66 – column 3, line 5), there is no teaching of selecting first and second lists of cells from a ranked list of monitored cells, nor of searching the first list during each cycle, and a subset of the second list during each cycle. Rather, in Chheda, the entire neighbor list is searched whenever neighbor list searching is performed. While Chheda does discuss other sets, such as the active set, candidate set, remaining set, and so forth, Chheda is silent as to ranking those cells, and selecting the first and second lists therefrom.

Various other limitations are also missing from Chheda, such as the selected subset varying during each cycle. This is because Chheda does not teach the lists, subset, cycles, or series of cycles. The Examiner remarks that Chheda discloses “continuously updating the active list, hence the remaining list will also reflect changes”, supposedly found at Column 4 line 59-column 5 line 52. This citation does not teach “continuously updating” the active list. Furthermore, claim 1 does not recite continuously updating an active list (or a remaining list). Rather, a plurality of cells is detected by the searcher, a processor ranks the list to form a ranked list of monitored cells, a first and second list of cells is generated, the searcher searches the first list and a subset of the second list during a cycle, and the selected subset varies during each cycle. Chheda does not teach these limitations, so the rejection to claims 1, 4, and 18, as well as their dependent claims, should be withdrawn.

With respect to claim 7, Chheda is silent as to round-robin selection of the subset from the second list, since Chheda is silent regarding the second list and selecting a subset thereof. Chheda merely speaks of differing search requirements for the active, candidate, neighbor, and remaining sets. Chheda does not teach round-robin searching between these sets. (And,

assuming arguendo that Chheda did so teach, it would not recite the limitations of claim 7, since these sets do not meet the limitations of claim 1, on which claim 7 depends).

With respect to claim 8, Chheda does not rank cells by decreasing order of measured signal strength. Rather, Chheda ranks cells by round-trip and one-way delay. The reference at Col. 2 line 49 et seq. teaches assigning some cells to certain sets when a threshold of signal strength is reached (i.e. the ADD threshold exceeded by pilot C/I), which is not a ranking of cells by decreasing order of measured signal strength.

With respect to claim 9, Chheda does not teach a detecting step repeated at a minimum frequency according to one or more pre-determined refresh parameters. The Examiner asserts that Chheda discloses updating at least during handoff. This is clearly not a pre-determined refresh parameter. For example, a mobile station may remain stationary, in which case it need never handoff, thus never update, according to the Examiner's statement. This would not meet the limitation of repeating at a minimum frequency according to one or more pre-determined refresh parameters.

With respect to claim 10, the Examiner confuses the teaching of handoff types (i.e. soft, softer, soft/softer, for search types. Various search techniques may be deployed in any given embodiment, and any single one of them could be used for all of the handoff types disclosed in Chheda.

For these reasons, and others which have been omitted for brevity, a prima facie case for anticipation has not been made for claims 1, 4, 7-12, 14-16, and 18, and the rejections should therefore be withdrawn.

35 U.S.C. §103

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation of, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference(s) must teach or suggest all the claim limitations.

For each §103(a) rejection in this Office Action, Applicants submit: the prior art of record does not provide a suggestion or motivation to modify the reference; there is not a reasonable expectation of success, and the reference does not teach or suggest all the claim limitations.

Each of the Examiner's rejections uses Chheda as the basis for teaching one or more claimed elements. The arguments detailed above regarding Chheda thus apply to each of these rejections as well. Thus, the *prima facie* case of obviousness is not made, as not all of the claim limitations are taught or suggested. Various limitations in the dependent claims are also missing from the combined references. Therefore, the rejections to claims 2, 3, 5, 6, 13 and 17 should be withdrawn.

Furthermore, the Examiner has failed to point out where the suggestion or motivation to combine the references is given. Thus, the *prima facie* case of obviousness fails for lacking a suggestion to modify or combine reference teachings, and the rejections should be withdrawn for this reason as well.

Furthermore, various dependent limitations are missing in the references as well. With respect to claims 2 and 5, Bomar does not teach a pre-determined search number. The number of base stations in Bomar's active set does not anticipate a processor comparing the number of cells in the list of monitored cells to a pre-determined search number, and wherein the ranking, selecting the first list, and selecting the subset are performed when the monitored list is greater than the pre-determined search number. The Examiner asserts that Bomar teaches "optimizing the active set by reaching the maximum capacity", which is not a limitation of any of the claims. Neither Bomar nor Chheda teach the limitations of claims 2 and 5.

With respect to claims 3 and 6, all the above arguments continue to apply. Furthermore, in neither Bomar nor Chheda (nor their combination) is it taught that a processor directs the searcher to search each cell in the list of monitored cells when the number of cells in the monitored list is less than or equal to the pre-determined search number. Using the Examiner's characterization of Chheda above (which the Applicants respectfully traverse), this would require the entire set of cells (i.e. the active, candidate, neighbor, and remaining sets) to be searched when the monitored list is less than or equal to a search number. By contrast, Chheda

teaches specifically that all the sets are not searched at once (see the Examiner's citation of column 3, lines 3-14 of Chheda).

With respect to claims 13 and 17, the Examiner asserts that Lescuyer and Chheda teach the "purpose of allowing handovers between different systems to coverage, load balancing constraints." Applicants are not sure what this assertion means, but note that it is not a claim limitation.

Specification

Applicants provide herewith amendments to the specification. The amendments to the specification are made by presenting marked up replacement paragraphs which identify changes made relative to the immediate prior version.

The changes made are primarily typographical or grammatical in nature, or involve minor clarifications of awkward wordings.

While Applicants believe that the title as filed meets all the statutory requirements, an amendment is made to the title as shown, incorporating portions of the Examiner's suggestions. The title should be as short and specific as possible, per 37 C.F.R. 1.72.

The abstract is corrected according to the Examiner's requirement.

The missing application number is inserted in paragraph [1060], per the Examiner's suggestion.

The text in paragraph [1020] has been amended to overcome the Examiner's objection to FIG. 1, and to reference numbers 104a, 104b, 105c, 106a, and 106b, in particular. With the amendments as shown above, no amendment to the drawings will be necessary.

Applicants believe these changes add no new matter to the application and are fully supported by the original disclosure.

REQUEST FOR ALLOWANCE

In view of the foregoing, Applicants submit that all pending claims in the application are patentable. Accordingly, reconsideration and allowance of this application is earnestly solicited.

Should any issues remain unresolved, the Examiner is encouraged to telephone the undersigned at the number provided below.

Respectfully submitted,

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